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Name: Edgar Benavides

By: 

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application for:

Inventors: Jin JEN, et al.

Serial No.: 09/646,478

Filing Date: September 15, 2000

For: METHODS FOR THE DIAGNOSIS
AND TREATMENT OF LUNG CANCER

Commissioner for Patents
Washington, DC 20231
Box PCT
Attention: PCT Legal Office

Sir:

**RENEWED REQUEST UNDER 37 C.F.R. § 1.497(d)
AND PETITION FOR SUSPENSION OF THE RULES UNDER 37 C.F.R. § 1.183**

This Renewed Request is filed in response to the Decision dated March 20, 2002, a copy of which is enclosed. A period of two months to file a response was granted, i.e., by May 20, 2002. Accordingly, this Renewed Request is timely filed.

The March 20, 2002 Decision noted that the Petition filed March 4, 2002 was incomplete because, unlike the undersigned attorney's file (hereinafter "Applicants' file"), the Prosecution by Assignee in the Office's file does not name John Hopkins University ("University") as the assignee of an interest in the Application. A copy of the Office's copy is attached.

A copy of the Prosecution by Assignee executed by the University from Applicants' file is attached. The University is the joint owner of the subject application by virtue of an assignment recorded January 17, 2001 on Reel 011456, Frame 0750. A copy of the Notice of Recordation also is enclosed. Yet further enclosed is a declaration by Mary R. Zimmerman attesting to the mailing and filing on April 25, 2001 of the original Prosecution by Assignee executed by the University.

In view of the enclosed documents, Applicants respectfully request reconsideration of the Decision filed March 4, 2002. Without deceptive intent, an erroneous Prosecution by Assignee was filed. See also copy of March 29, 2001 letter (redacted) to the University requesting execution of the corrected document.

Applicants also respectfully request a filing date be accorded to the subject application. Applicants' attorney further Petitions for any and all relief required to perfect the filing of the subject application before the U.S. Patent and Trademark Office. All fees which may be due in connection with the granting of this relief may be charged to Deposit Account No. 50-1189 (Billing Ref.: 19442-7030).

If a telephone interview would advance processing and examination of the subject application, the Office is invited to contact the undersigned at 650-849-4950.

Respectfully submitted,

Dated: May 14, 2002

By: Antoinette F. Konski
Antoinette F. Konski
Registration No.: 34,202

McCutchen, Doyle, Brown & Enersen, LLP
Three Embarcadero Center, Suite 1800
San Francisco, California 94111
Telephone: (650) 849-4950
Telefax: (650) 849-4800



MAR 20 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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MD&E

Antoinette F. Konski
McCutchen, Doyle, Brown & Enersen LLP
3 Embarcadero Center, Suite 1800
San Francisco, CA 94111

In re Application of JEN et al :
U.S. Application No.: 09/646,478 :
Int. Application No.: PCT/US99/06947 : DECISION
Int. Filing Date: 30 March 1999 :
Priority Date: 31 March 1998 :
Attorney Docket No.: 126881201800 :
For: METHODS FOR THE DIAGNOSIS AND :
TREATMENT OF LUNG CANCER :

This is in response to applicants' "Renewed Request Under 37 C.F.R. § 1.497(d) and Petition for Suspension of the Rules Under 37 C.F.R. § 1.183" filed 04 March 2002.

BACKGROUND

On 30 March 1999, applicants filed international application PCT/US99/06947, which claimed priority of an earlier United States application filed 31 March 1998. A Demand for international preliminary examination, in which the United States was elected, was filed on 12 October 1999, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 30 September 2000.

On 15 September 2000, applicants filed national stage papers in the United States. The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 13 October 2000, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), indicating that an oath or declaration in compliance with 37 CFR 1.497 must be filed along with a surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty (30) months from the priority date.

On 17 January 2001, applicants filed a "Response to Notice of Missing Requirements" which included, *inter alia*, a declaration, an assignment document, and the required late declaration surcharge.

On 20 April 2001, the DO/EO/US mailed a Notification of a Defective Response (Form PCT/DO/EO/916) along with a Notification of a Defective Oath or Declaration (Form PCT/DO/EO/917) indicating that the declaration filed 17 January 2001 is improper since the declaration lists an inventor who is not listed on the international application.

On 21 May 2001, applicants filed a request to correct inventorship under 37 CFR 1.497(d).

On 14 August 2001, this Office mailed a decision dismissing the 21 May 2001 request to correct inventorship.

On 04 March 2002, applicants filed the present renewed request under 37 CFR 1.497(d) along with new declarations.

DISCUSSION

The declarations filed 04 March 2002 are in proper format and list David Sidransky as an additional inventor beyond those indicated in the international application.

37 CFR 1.497(d) (effective 07 November 2000) states,

If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, the oath or declaration must be accompanied by: (1) a statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part; (2) the processing fee set forth in § 1.17(i); and (3) if an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter).

With regard to item (1) above, applicants have provided the requisite statement from the purported inventor Sidransky.

With regard to item (2) above, the requisite fee has been provided.

With regard to item (3) above, the assignee must establish ownership of the application in order to consent to a correction of inventorship. See MPEP 324. On 30 March 2001, applicants filed a "Prosecution by Assignee and Power of Attorney Under 37 C.F.R. § 3.71" which states that AgraQuest, Inc. is the assignee of the entire right, title, and interest in the present application.

Under 37 CFR 3.73(b)(1), ownership of the application may be established by: (i) submitting documentary evidence of a chain of title from the original owner to the assignee; or (ii) specifying by reel and frame number where such evidence is recorded in the USPTO. In the

present case, applicants have not provided documentary evidence of a chain of title from each of the inventors to AgraQuest, Inc., nor have applicants specified by reel and frame number where such evidence is recorded in the USPTO.

It is further noted that the consent statements filed with the renewed request do not state that the persons signing the statements are authorized to act on behalf of AgraQuest, Inc., nor are the consent statements signed by persons with apparent authority to sign on behalf of AgraQuest, Inc. See 37 CFR 3.73(b)(2).

CONCLUSION

Because applicants have failed to satisfy item (3) above, the renewed request under 37 CFR 1.497(d) is DISMISSED without prejudice.

If reconsideration on the merits of this decision is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file a proper response will result in ABANDONMENT of the application. Any reconsideration request should include a cover letter entitled "Renewed Request Under 37 CFR 1.497(d)" and should also properly establish consent of the assignee as discussed above. Extensions of time may be obtained pursuant to 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to the Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.



Bryan Tung
PCT Legal Examiner
PCT Legal Office

Telephone: 703-308-6614

Facsimile: 703-308-6459

PCT Help Desk
United States Patent and Trademark Office
Box PCT
Washington, DC 20231
Telephone: (703) 305-3257
Facsimile: (703) 305-2919

Facsimile Cover Sheet

To: <u>Antoinette Konksi</u>	From: <u>Bryan Tung</u>
Fax: <u>650-849-4800</u>	Pages: <u>3</u>
Phone: _____	Date: <u>26 March 2002</u>
Re: <u>09/646,478</u>	CC: _____

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

TRANSMITTAL
FORM

(to be used for all correspondence after filing)

Total number of Pages in this submission.

Application Number	09/646,478
Filing Date	September 15, 2000
First Named Inventor	JEN et al.
Group Art Unit	NYA
Examiner Name	NYA
Attorney Docket No.	126881201800

Commissioner of Patents
Washington, D.C. 20231

ENCLOSURES (check all that apply)

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|--|--|---|
| <input type="checkbox"/> FEE TRANSMITTAL FORM
<input type="checkbox"/> FEE ATTACHED | <input type="checkbox"/> ASSIGNMENT PAPERS
(FOR AN APPLICATION) | <input type="checkbox"/> AFTER ALLOWANCE
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| <input type="checkbox"/> AMENDMENT/RESPONSE
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OF APPEALS AND INTERFERENCES |
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PAPERS | |
| <input type="checkbox"/> EXTENSION OF TIME | <input type="checkbox"/> PETITION ROUTING SLIP
(PTO/SB/60) AND
ACCOMPANYING
PETITION) | <input type="checkbox"/> APPEAL COMMUNICATION TO GROUP
(APPEAL NOTICE, BRIEF, REPLY BRIEF) |
| <input type="checkbox"/> EXPRESS ABANDONMENT REQUEST | <input type="checkbox"/> TO CONVERT A
PROVISIONAL
APPLICATION | <input type="checkbox"/> PROPRIETARY INFORMATION |
| <input type="checkbox"/> INFORMATION DISCLOSURE
STATEMENT W/1449 | <input type="checkbox"/> POWER OF ATTORNEY,
REVOCATION CHANGE OF
CORRESPONDENCE ADDRESS | <input type="checkbox"/> STATUS LETTER |
| <input type="checkbox"/> CERTIFIED COPY OF PRIORITY
DOCUMENT(S) | <input type="checkbox"/> TERMINAL DISCLAIMER | <input checked="" type="checkbox"/> ADDITIONAL ENCLOSURE(S)
(PLEASE IDENTIFY BELOW): |
| <input type="checkbox"/> RESPONSE TO MISSING PARTS/
INCOMPLETE APPLICATION
<input type="checkbox"/> RESPONSE TO MISSING PARTS
UNDER 37 CFR 1.52 OR 1.53
COPY OF PTO-1533 | <input type="checkbox"/> SMALL ENTITY STATEMENT
<input type="checkbox"/> REQUEST FOR REFUND | PROSECUTION BY ASSIGNEE AND POWER OF
ATTORNEY UNDER 37 C.F.R. § 3.71; RETURN
POSTCARD |
| <input type="checkbox"/> ISSUE FEE TRANSMITTAL
<input type="checkbox"/>
<input type="checkbox"/> | REMARKS: | |

BAKER & MCKENZIE
660 HANSEN WAY
PALO ALTO, CALIFORNIA 94304
TELEPHONE: (650) 856-2400
FACSIMILE: (650) 856-9299

DATE: MARCH 28, 2001

BY: 

ANTONETTE F. KONSKI, REG. NO. 34,202

CERTIFICATE OF MAILING BY "FIRST CLASS MAIL"

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents, Washington, D.C. 20231 on this date: March 28, 2001.

By: 

Name of person signing: Mary R. Zimmerman



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Application for:

Jin JEN, et al.

Application Serial No.: 09/646,478
(PCT/US99/06947)

Filing Date: September 15, 2000 (March 30, 1999)

For: **METHODS FOR THE DIAGNOSIS AND
TREATMENT OF LUNG CANCER**

Examiner: Unassigned

Group Art Unit: Unassigned

Attorney's Docket No. 126881-201800

**PROSECUTION BY ASSIGNEE AND POWER OF ATTORNEY
UNDER 37 C.F.R. § 3.71**Commissioner for Patents
Washington, D.C. 20231

Sir:

AgraQuest, Inc., the assignee of the entire right, title and interest in this patent application, under 37 C.F.R. § 3.71 hereby appoints:

Antoinette F. Konski
Mark Della Valle
Michele Todd WasmuthReg. No. 34,202
Reg. No. 34,147
Reg. No. 43,239

all of the firm Baker & McKenzie, 660 Hansen Way, Palo Alto, CA 94304, to prosecute this application and transact all matters in the U.S. Patent and Trademark Office connected therewith, said appointment to be to the exclusion of the inventors and their attorneys in accordance with the provisions of 37 C.F.R. § 3.71.

Please direct all written communications relative to this application to:

Antoinette F. Konski
Baker & McKenzie
660 Hansen Way
Palo Alto, California 94304

Please direct all telephone communications to Antoinette F. Konski at (650) 856-5564.

John Hopkins University

Dated: 3/12/01By: R. Keith Baker

Name: R. Keith Baker, Ph.D.

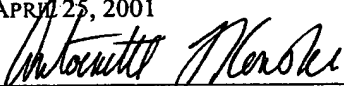
Title: Acting Director, Office of Technology Licensing

Address: 111 Market Place, Suite 906
Baltimore, Maryland 21202

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

TRANSMITTAL FORM <i>(to be used for all correspondence after filing)</i> Total number of Pages in this submission 10	Application Number	09/646,478
	Filing Date	September 15, 2000
	First Named Inventor	JEN et al.
	Group Art Unit	NYA
	Examiner Name	NYA
	Attorney Docket No.	126881201800

Commissioner of Patents
Washington, D.C. 20231

ENCLOSURES (check all that apply)		
<input type="checkbox"/> FEE TRANSMITTAL FORM <input type="checkbox"/> FEE ATTACHED <input type="checkbox"/> AMENDMENT/RESPONSE <input type="checkbox"/> AFTER FINAL <input type="checkbox"/> AFFIDAVITS' DECLARATION(S) <input type="checkbox"/> EXTENSION OF TIME <input type="checkbox"/> EXPRESS ABANDONMENT REQUEST <input type="checkbox"/> INFORMATION DISCLOSURE STATEMENT W/1449 <input type="checkbox"/> CERTIFIED COPY OF PRIORITY DOCUMENT(S) <input type="checkbox"/> RESPONSE TO MISSING PARTS/ INCOMPLETE APPLICATION <input type="checkbox"/> RESPONSE TO MISSING PARTS UNDER 37 CFR 1.52 OR 1.53 COPY OF PTO-1533 <input type="checkbox"/> ISSUE FEE TRANSMITTAL <input type="checkbox"/> <input type="checkbox"/>	<input type="checkbox"/> ASSIGNMENT PAPERS (FOR AN APPLICATION) <input type="checkbox"/> DRAWING(S) <input type="checkbox"/> LICENSING-RELATED PAPERS <input type="checkbox"/> PETITION ROUTING SLIP (PTO/SB/60) AND ACCOMPANYING PETITION) <input type="checkbox"/> TO CONVERT A PROVISIONAL APPLICATION <input type="checkbox"/> POWER OF ATTORNEY, REVOCATION CHANGE OF CORRESPONDENCE ADDRESS <input type="checkbox"/> TERMINAL DISCLAIMER <input type="checkbox"/> SMALL ENTITY STATEMENT <input type="checkbox"/> REQUEST FOR REFUND	<input type="checkbox"/> AFTER ALLOWANCE COMMUNICATION TO GROUP <input type="checkbox"/> APPEAL COMMUNICATION TO BOARD OF APPEALS AND INTERFERENCES <input type="checkbox"/> APPEAL COMMUNICATION TO GROUP (APPEAL NOTICE, BRIEF, REPLY BRIEF) <input type="checkbox"/> PROPRIETARY INFORMATION <input type="checkbox"/> STATUS LETTER <input checked="" type="checkbox"/> ADDITIONAL ENCLOSURE(S) (PLEASE IDENTIFY BELOW): PROSECUTION BY ASSIGNEE AND POWER OF ATTORNEY UNDER 37 C.F.R. § 3.71, STATEMENT UNDER 37 CFR 3.73(b) WITH COPY OF PREVIOUSLY RECORDED ASSIGNMENT; RETURN POSTCARD
REMARKS:		
BAKER & MCKENZIE 660 HANSEN WAY PALO ALTO, CALIFORNIA 94304 TELEPHONE: (650) 856-2400 FACSIMILE: (650) 856-9299	DATE: APR 25, 2001 BY:  ANTOINETTE F. KONSKI, REG. NO. 34,202	
CERTIFICATE OF MAILING BY "FIRST CLASS MAIL"		
I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents, Washington, D.C. 20231 on this date: April 25, 2001.		
By: _____ Name of person signing: Mary R. Zimmerman		

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application for:

Jin JEN, et al.

Application Serial No.: 09/646,478
(PCT/US99/06947)

Filing Date: September 15, 2000 (March 30, 1999)

For: **METHODS FOR THE DIAGNOSIS AND
TREATMENT OF LUNG CANCER**

Examiner: Unassigned

Group Art Unit: Unassigned

Attorney's Docket No. 126881-201800

**PROSECUTION BY ASSIGNEE AND POWER OF ATTORNEY
UNDER 37 C.F.R. § 3.71**

Commissioner for Patents
Washington, D.C. 20231

Sir:

Johns Hopkins University, an assignee of the right, title and interest in this patent application,
under 37 C.F.R. § 3.71 hereby appoints:

Antoinette F. Konski
Mark Della Valle
Michele Todd Wasmuth

Reg. No. 34,202
Reg. No. 34,147
Reg. No. 43,239

all of the firm Baker & McKenzie, 660 Hansen Way, Palo Alto, CA 94304, to prosecute this application
and transact all matters in the U.S. Patent and Trademark Office connected therewith, said appointment
to be to the exclusion of the inventors and their attorneys in accordance with the provisions of 37 C.F.R.
§ 3.71.


Please direct all written communications relative to this application to:

Antoinette F. Konski
Baker & McKenzie
660 Hansen Way
Palo Alto, California 94304

Please direct all telephone communications to Antoinette F. Konski at (650) 856-5564.

John Hopkins University

Dated: 4/4/01

By: 
Name: **R. Keith Baker, Ph.D.**
Title: **Acting Director, Office of Technology
Licensing**
Address: **111 Market Place, Suite 906
Baltimore, Maryland 21202**

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

STATEMENT UNDER 37 CFR 3.73(b)

Applicant/Patent Owner: Jin JEN, et al.

Application No./Patent No.: 09/646,478 Filed/Issue Date: September 15, 2000

Entitled: Methods for the Diagnosis and Treatment of Lung Cancer

John Hopkins Univeristy, a Maryland

(Name of Assignee)

(Type of Assignee, e.g., corporation, partnership, university, government agency, etc.)

states that it is:

1. ☐ the assignee of the entire right, title, and interest; or
2. ☒ an assignee of an undivided part interest

in the patent application/patent identified above by virtue of either:

- A. ☒ An assignment from the inventor(s) of the patent application/patent identified above. The assignment was recorded in the Patent and Trademark Office at Reel _____, Frame _____, or for which a copy thereof is attached.

OR

- B. ☐ A chain of title from the inventor(s), of the patent application/patent identified above, to the current assignee as shown below:

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The document was recorded in the United States Patent and Trademark Office at
Reel _____, Frame _____, or for which a copy thereof is attached.

2. From: _____ To: _____
The document was recorded in the United States Patent and Trademark Office at
Reel _____, Frame _____, or for which a copy thereof is attached.

3. From: _____ To: _____
The document was recorded in the United States Patent and Trademark Office at
Reel _____, Frame _____, or for which a copy thereof is attached.

☐ Additional documents in the chain of title are listed on a supplemental sheet.

☒ Copies of assignments or other documents in the chain of title are attached.

[NOTE: A separate copy (i.e., the original assignment document or a true copy of the original document) must be submitted to Assignment Division in accordance with 37 CFR Part 3, if the assignment is to be recorded in the records of the USPTO. See MPEP 302.8]

The undersigned (whose title is supplied below) is empowered to sign this statement on behalf of the assignee.

02/19/01
Date


Signature

Nina Ossanna, Ph.D.

Typed or printed name

Director, Office of Technology Licensing

Title

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UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APRIL 06, 2001

PTAS



101597761A

BAKER & MCKENZIE
ANTOINETTE F. KONSKI
660 HASEN WAY
PALTO ALTO, CA 94304

UNITED STATES PATENT AND TRADEMARK OFFICE
NOTICE OF RECORDATION OF ASSIGNMENT DOCUMENT

THE ENCLOSED DOCUMENT HAS BEEN RECORDED BY THE ASSIGNMENT DIVISION OF THE U.S. PATENT AND TRADEMARK OFFICE. A COMPLETE MICROFILM COPY IS AVAILABLE AT THE ASSIGNMENT SEARCH ROOM ON THE REEL AND FRAME NUMBER REFERENCED BELOW.

PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT AND TRADEMARK ASSIGNMENT SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR HAVE QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE EMPLOYEE WHOSE NAME APPEARS ON THIS NOTICE AT 703-308-9723. PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, ASSIGNMENT DIVISION, BOX ASSIGNMENTS, CG-4, 1213 JEFFERSON DAVIS HWY, SUITE 320, WASHINGTON, D.C. 20231.

RECORDATION DATE: 01/17/2001

REEL/FRAME: 011456/0750
NUMBER OF PAGES: 5

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:
JEN, JIN

DOC DATE: 01/03/2001

ASSIGNOR:
SIDRANSKY, DAVID

DOC DATE: 01/04/2001

ASSIGNEE:
JOHN HOPKINS UNIVERSITY SCHOOL OF
MEDICINE
824 ROSS RESEARCH BLDG/ 720
RUTLAND AVENUE
BALTIMORE, MARYLAND 21202

SERIAL NUMBER: 09646478
PATENT NUMBER:

FILING DATE:
ISSUE DATE:

Baker & McKenzie

APR 12 2001

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Patent Dept.

011456/0750 PAGE 2

SHAREILL COLES, EXAMINER
ASSIGNMENT DIVISION
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01-29-2001

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I hereby certify that this correspondence
envelope addressed to: **Box Assignment**

Name: **C. Fong**



101597761

Patent Service as first class mail in an
C. 20231, on **January 11, 2001**

U.S. DEPARTMENT OF COMMERCE

RECORDATION FORM COVER SHEET

PATENTS ONLY

Patent and Trademark Office

Attorney's Docket No. 126881-201800

To the Commissioner of Patents and Trademarks: Please record the attached original documents or copy thereof.

1. Name of conveying party(ies): **JinJen; and David Sidransky**

- ☒ Individual(s) ☐ Association
☐ General Partnership ☐ Limited Partnership
☐ Corporation-State ☐ Other

Additional name(s) of conveying party(ies) attached? ☐ Yes ☒ No

3. Nature of conveyance:

- ☒ Assignment ☐ Merger
☐ Security Agreement ☐ Change of Name
☐ Other:

Execution Date: **January 3 and 4, 2001**

2. Name and address of receiving party(ies):

Name: **John Hopkins University**
 Address: **School of Medicine**
 824 Ross Research Building
 720 Rutland Avenue
 City: **Baltimore** State: **Maryland** Zip Code: **21202 USA**

Additional name(s) & address(es) attached? ☐ Yes ☒ No

4. Application number(s) or patent number(s): **09/646,478**

If this document is being filed with a new application, the execution date of the application is:

A. Patent Application No.(s):

B. Patent No.(s):

Additional numbers attached? ☐ Yes ☒ No

5. Name and address of party to whom correspondence concerning document should be mailed:

Antoinette F. Konski
Baker & McKenzie
660 Hansen Way
Palo Alto, California 94304

6. Total number of applications and patents involved: **1**7. Total fee (37 C.F.R. § 3.41): **\$40.00**

- ☒ Enclosed
☐ Authorized to be charged to deposit account, referencing
 Attorney Docket No.

8. Deposit account number: **50-0974**

The Commissioner is hereby authorized to charge any fees under 37 C.F.R. §1.21 that may be required by this paper, or to credit any overpayment to Deposit Account No. 50-0974

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9. Statement and signature.

To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document.

Name: **Antoinette F. Konski (Reg. No. 34,202)**

Signature

Date: **January 11, 2001**

Total number of pages comprising cover sheet, attachments and document: **5**

Mail documents to be recorded with required cover sheet information to:

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 Washington, D.C. 20231

01/26/2001 GTON11 00000202 09646478

01 FC:581

40.00 DP

157326.1

195072v1

ASSIGNMENT
JOINT

THIS ASSIGNMENT, by Jin Jen and David Sidransky (hereinafter referred to as the assignors), residing at 2104 Heritage Drive, Baltimore, Maryland 21209 and 3007 Northbrook Rd., Baltimore, Maryland 21209 respectively, witnesseth:

WHEREAS, said assignors have invented certain new and useful improvements in **METHODS FOR THE DIAGNOSIS AND TREATMENT OF LUNG CANCER**, set forth in an application for Letters Patent of the United States, bearing Serial No. 09/646,478, based on PCT International PCT/US99/06947, filed on March 30, 1999, and

WHEREAS, John Hopkins University, a university duly organized under and pursuant to the laws of Maryland and having its principal place of business at School of Medicine, 824 Ross Research Building, 720 Rutland Avenue, Baltimore, MD 21202 (hereinafter referred to as the assignee) is desirous of acquiring the entire right, title and interest in and to said inventions and said application for Letters Patent of the United States, and in and to any Letters Patent or Patents, United States or foreign, to be obtained therefor and thereon:

NOW, THEREFORE, in consideration of One Dollar (\$1.00) and other good and sufficient consideration, the receipt of which is hereby acknowledged, said assignors have sold, assigned, transferred and set over, and by these presents does sell, assign, transfer and set over, unto said assignee, its successors, legal representative and assigns, the entire right, title and interest in and to the above-mentioned inventions, application for Letters Patent, and any and all Letters Patent or Patents in the United States of America and all foreign countries which may be granted therefor and thereon, and in and to any and all divisions, continuations and continuations-in-part of said application, or reissues or extensions of said Letters Patent or Patents, and all rights under the International Convention for the Protection of Industrial Property, the same to be held and enjoyed by said assignee, for its own use and the use of its successors, legal representative and assigns, to the full end of the term or terms for which Letters Patent or Patents may be granted, as fully and entirely as the same would have been held and enjoyed by the assignors, had this sale and assignment not been made.


AND for the same consideration, said assignors hereby covenant and agree to and with said assignee its successors, legal representatives and assigns, that, at the time of execution and delivery of these presents, said assignors are the joint and lawful owners of the entire right, title and interest in and to said inventions and the application for Letters Patent above-mentioned, and that the same are unencumbered and that said assignors have good and full right and lawful authority to sell and convey the same in the manner herein set forth.

AND for the same consideration, said assignors hereby covenant and agree to and with said assignee, its successors, legal representatives and assigns, that said assignors will, whenever counsel of said assignee, or the counsel of its successors, legal representative and assigns, shall advise that any proceeding in connection with said inventions, or said application for Letters Patent, or any proceeding in connection with Letters Patent for said inventions in any country, including interference proceedings, is lawful and desirable, or that any division, continuation or continuation-in-part of any application for Letters Patent or any reissue or extension of any Letters Patent, to be obtained thereon, is lawful and desirable, sign all papers and documents, take all lawful oaths, and do all acts necessary or required to be done for the procurement, maintenance, enforcement and defense of Letters Patent for said inventions, without charge to said assignee, its successors, legal representatives and assigns, but at the cost and expense of said assignee, its successors, legal representatives and assigns.

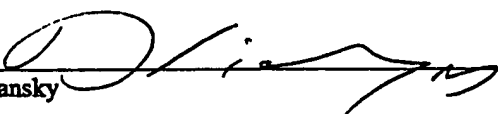
PATENT

AND said assignors hereby request the Commissioner of Patents to issue said Letters Patent of the United States to said assignee as the assignee of said inventions and the Letters Patent to be issued thereon for the sole use of said assignee, its successors, legal representatives and assigns.

1/3/01
Date


Jin Jen

1/4/01
Date


David Sidransky

ASSIGNMENT

We, Jin Jen and David Sidransky, whose full post office addresses are 2412 St. George Way, Brookeville, Maryland 20833 and 3007 Northbrook Road, Baltimore, Maryland 21209, respectively, in consideration of \$1.00, the receipt of which is hereby acknowledged and other good and valuable consideration, do hereby sell and assign to John Hopkins University, whose full post office address is School of Medicine, 824 Ross Research Building, 720 Rutland Avenue, Baltimore, Maryland 21205, all our rights, title and interests in Canada in and to the invention disclosed in an application for patent relating to, and entitled **METHODS FOR THE DIAGNOSIS AND TREATMENT OF LUNG CANCER**, the application originating from PCT application number PCT/US99/06947 and bearing the Canadian Patent Application No. 2,323,058, and international filing date of 30 March 1999, and to all our corresponding rights, title and interests in and to any patent which may be, or has been granted therefor.

The Assignors hereby require that this assignment be drawn in the English language.

SIGNED at Bethesda, MD. USA.
City and State Country

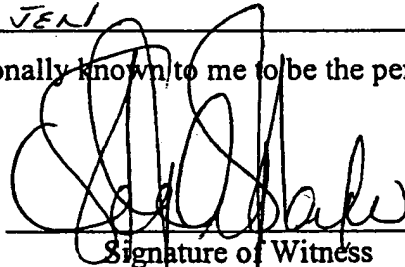
This 3rd day of January, 2000.


Jin Jen

STATEMENT BY WITNESS

I, STEPHANIE FLAHER whose full post office address is
14809 CHERRY LEAF TERRACE, SILVER SPRING, MD 20906

was personally present and did see JIN JEN execute the
within assignment and such assignor is personally known to me to be the person described in
such document.


Signature of Witness 01/03/01

SIGNED at BALTIMORE, MD USA
City and State Country

This 4 day of JANUARY, 2000.

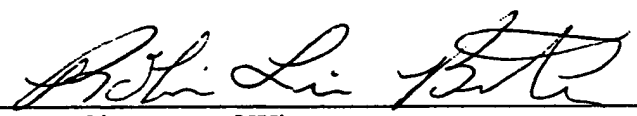


David Sidransky

STATEMENT BY WITNESS

I, ROBIN LIN BREWSTER whose full post office address is
602 N CHURCHILL RD., BEL AIR, MD 21014

was personally present and did see DAVID SIDRANSKY, M.D. execute the
within assignment and such assignor is personally known to me to be the person described in
such document.



Signature of Witness

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application for:

Jin JEN et al.

Serial No.: 09/646,478

Filing Date: September 15, 2000

For: METHODS FOR THE DIAGNOSIS
AND TREATMENT OF LUNG
CANCER

DECLARATION

Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

I, Mary R. Zimmerman, declare as follows:

1. That from March 27, 2001 through July 31, 2001, I was an employee of the law firm of Baker & McKenzie, 660 Hansen Way, Palo Alto, CA 94304.

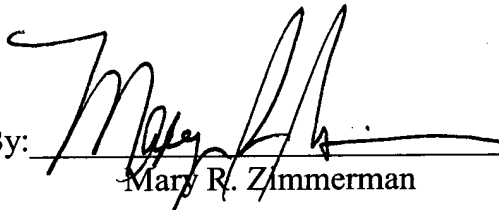
2. That on April 25, 2001, while employed at Baker & McKenzie, I did file with the Commissioner of Patents, Washington, DC 20231, by depositing with the United States Postal Service as first class mail in an envelope with sufficient postage, the following documents in connection with the above-identified non-provisional application:

Transmittal Form, Prosecution by Assignee and Power of Attorney
Under 37 C.F.R. § 3.71 (signed by a representative of Johns Hopkins
University), Statement under 37 CFR 3.73(b) (signed by a representative of

Johns Hopkins University) with copy of previously recorded assignment and return postcard.

3. That due to a clerical error on my part, said transmittal did not contain a signed certificate of mailing.

4. That all statements made herein are of my own knowledge and are true; and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code.

Date: April 9, 2002 By: 
Mary R. Zimmerman

CA0130112

BAKER & MCKENZIE

ATTORNEYS AT LAW

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ANTOINETTE F. KONSKI
(650) 856-5664
antoINETTE.f.konski@bakernet.com

March 29, 2001

Patent Coordinator
John Hopkins University
School of Medicine
111 Market Place, Suite 906
Baltimore, Maryland 21202

Re: U.S. Patent Application Serial No. 09/646,478
(Based Upon PCT Application Serial No. PCT/US99/06947)
Filed: September 15, 2000
For: *Methods for the Diagnosis and Treatment of Lung Cancer*
Inventors: Jen, et al.
JHU Reference:
Our Reference: 68126881-2018.00

Dear

In connection with the above-referenced application, we are enclosing a new Prosecution by Assignee and Power of Attorney form for Nina R. Keith Baker to sign and date in blue ink. When preparing this document for filing we found an error needing correction. Please accept my apologies for the inconvenience. Please return this executed document to us as soon as possible.

Please feel free to contact me if you have any questions.

Sincerely,


Antoinette F. Konski

Enclosure: Prosecution by Assignee and Power of Attorney

REC'D APR 02 2001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application for:

Jin JEN, et al.

Application Serial No.: 09/646,478
(PCT/US99/06947)

Filing Date: September 15, 2000 (March 30, 1999)

For: **METHODS FOR THE DIAGNOSIS AND
TREATMENT OF LUNG CANCER**

Examiner: Unassigned

Group Art Unit: Unassigned

Attorney's Docket No. 126881-201800

**PROSECUTION BY ASSIGNEE AND POWER OF ATTORNEY
UNDER 37 C.F.R. § 3.71**

Commissioner for Patents
Washington, D.C. 20231

Sir:

Johns Hopkins University, an assignee of the right, title and interest in this patent application,
under 37 C.F.R. § 3.71 hereby appoints:

Antoinette F. Konski
Mark Della Valle
Michele Todd Wasmuth

Reg. No. 34,202
Reg. No. 34,147
Reg. No. 43,239

all of the firm Baker & McKenzie, 660 Hansen Way, Palo Alto, CA 94304, to prosecute this application
and transact all matters in the U.S. Patent and Trademark Office connected therewith, said appointment
to be to the exclusion of the inventors and their attorneys in accordance with the provisions of 37 C.F.R.
§ 3.71.

Please direct all written communications relative to this application to:

Antoinette F. Konski
Baker & McKenzie
660 Hansen Way
Palo Alto, California 94304

Please direct all telephone communications to Antoinette F. Konski at (650) 856-5564.

John Hopkins University

Dated: _____

By: _____

Name: **R. Keith Baker, Ph.D.**

Title: **Acting Director, Office of Technology
Licensing**

Address: **111 Market Place, Suite 906
Baltimore, Maryland 21202**